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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,041	09/22/2003	Ann M. Panek	FER-15009	7293
7609	7590	01/18/2005	EXAMINER	
RANKIN, HILL, PORTER & CLARK, LLP 925 EUCLID AVENUE, SUITE 700 CLEVELAND, OH 44115-1405			LEE, RIP A	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/668,041	PANEK ET AL.	
	Examiner	Art Unit	
	Rip A. Lee	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/03/04; 02/12/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,936,512 to Tabara *et al.*

The prior art of Tabara *et al.* discloses a composition comprised of a blend of 5-40 wt % of at least one polyolefin and 0.01-15 wt % of at least one surface active compound (claim 1). In one aspect of the invention, the polyolefin is a mixture of polyethylene and polypropylene (claim 4). Examples 32 and 33 illustrate such an embodiment with a 3:7 and 7:3 ratio of HDPE to isotactic polypropylene. HDPE is an ethylene copolymer containing at least one α -olefin, and the isotactic polypropylene is a homopolymer. The surface active agent is a non-ionic surfactant selected from polyoxyethylene alkyl ethers and polyoxyethylene sorbitan fatty acid esters (claims 9 and 10). Regarding claim 2, it has been held that the term “up to” includes zero as a lower limit. *In re Mochel*, 470 F.2d 638, 176 USPQ 194 (CCPA 1974). As such, the claim is rejected over the prior art.

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3. Claims 1-4, 6, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,290,822 to Rogers *et al.*

Rogers *et al.* teaches a composition comprised of a non-elastomeric olefin polymer selected from ethylene homopolymer or propylene homopolymer, about 3-30 pw of an elastomer resin, a polystyrene (also a polyolefin homopolymer resin), and a stability control agent selected from partial esters of long chain fatty acids (claim 1). According to the inventors, a suitable elastomer for the invention is ethylene-propylene copolymer rubber (EPR) containing about 30-72 w % ethylene and 28-70 wt % of propylene (col. 4, line 44). Stability control agents are described in detail in column 5. The partial esters of long chain fatty acids are members of a generic class known as surface active agents or surfactants (lines 14-16). Exemplary surfactants include sorbitan mono-, di-, and trioleates (lines 19-21). There is also mentioned polyoxyethylene sorbitan tetrastearate in col. 5, line 68 from U.S. Patent No. 4,214,054, the contents of which are incorporated by reference (see col. 5, line 8 of Rogers *et al.*). This compound is an ethoxylated sorbitan fatty acid ester. The stability control agent is used in an amount of 0.5-10 pw based on 100 pw of olefin polymer resin (col. 6, line 12). The reference also discloses a process for compounding the molten mixture by heating and masticating in a mixing zone of an extruder (col. 6, lines 30-32), injecting into a mold (col. 7, line 41 – col. 8, line 5). That the materials are used in certain end uses necessitates its removal from the mold, despite the fact that the patent does not recite this step specifically. Regarding claim 2, it has been held that the term “up to” includes zero as a lower limit. *In re Mochel*, 470 F.2d 638, 176 USPQ 194 (CCPA 1974). As such, the claim is rejected over the prior art.

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,290,822 to Rogers *et al.*

The discussion of the disclosures of the prior art of Rogers *et al.* from paragraph 3 of this office action is incorporated here by reference. The patent is silent with respect to the physical properties recited in present claim 8. However, one having ordinary skill in the art would have found it obvious to believe that the composition of the prior art exhibits essentially the same properties in light of the fact that it is essentially the same as that of the instant claims.[†]

[†] Products of identical chemical composition can not have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990).

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Since the PTO can not conduct experiments, the burden of proof is shifted to the Applicants to establish an unobviousness difference. *In re Fitzgerald*, 619 F.2d. 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112-2112.02.

7. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,936,512 to Tabara *et al.* in view of U.S. Patent No. 4,098,752 to Ohkawa *et al.*

The discussion of the disclosures of the prior art from paragraph 2 of this office action is incorporated here by reference. Although Tabara *et al.* claims use of polyoxyethylene sorbitan fatty acid esters, there is no guidance in the reference regarding the identity of such compounds. The prior art of Ohkawa *et al.* relates to polyolefin compositions containing polyoxyethylene sorbitan fatty acid esters (claim 1) with polyoxyethylene sorbitan monooleate, polyoxyethylene sorbitan trioleate, polyoxyethylene sorbitan monopalmitate, polyoxyethylene sorbitan monostearate, and polyoxyethylene sorbitan tristearate being representative species of the genus of polyoxyethylene sorbitan fatty acid esters (claims 2, 5, and 6). It would have been obvious to one having ordinary skill in the art to use the any of the compounds claimed in Ohkawa *et al.* in the composition described in Tabara *et al.* and thereby arrive at the subject matter of the present claims because these are well-known species of the genus taught in Tabara *et al.*, and one having ordinary skill in the art would have expected all species within the genus to produce a useful material.

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8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers *et al.* in view of U.S. Patent No. 4,333,974 to Davis.

The compositions of Rogers *et al.* have a variety of end uses as described in U.S. Patent No. 4,323,528 (Collins), the contents of which are incorporated by reference (see Rogers *et al.*, col. 8, line 47). According to the Collins reference, the foamed product has utility as an art form (col. 8, line 31). Further application as described in present claim 10 is not recited in either reference. Davis shows that foamed balls are used to make art forms such as figurines (see Figures). Here, detailed facial features are painted onto the foamed ball (col. 2, line 4 and col. 3, line 55 – col. 4, line 35). Thus, it would have been obvious to one having ordinary skill in the art to paint the molded part of Rogers *et al.* when it is used as an art form because, as shown in the Davis patent, such an art form is painted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).


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January 12, 2005